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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/631,583	08/03/2000	Gad Liwerant	VIDS-0001-P02	9242

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C/O PORTFOLIOIP  
P.O. BOX 52050  
MINNEAPOLIS, MN 55402

EXAMINER
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SALTARELLI, DOMINIC D

ART UNIT	PAPER NUMBER
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2623

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/07/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

09/631,583

Applicant(s)

LIWERANT ET AL.

Examiner

Dominic D. Saltarelli

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 and 36-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 36-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments, see pages 7-9, filed January 10, 2007, with respect to the rejections of claims 1 and 7 under 35 U.S.C 102(e) and 35 U.S.C. 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new grounds of rejection is made in view of Rothschild (US 2001/0047294 A1, of record) and "Streaming Email" (XP-002150023, supplied by applicant). Said new grounds are necessitated by applicant's amendments made on May 7, 2006, and therefore the current action is Final. See MPEP 707.07(a).
2. Applicant's arguments regarding the applicability of the Ellis, Rothschild, and "Streaming Email" references have been fully considered but they are not persuasive.

First, applicant argues that Ellis is not analogous art, stating the Ellis delivers video contents over a broadcast network, which is contrary to the claimed type of data network (applicant's remarks, page 9).

In response, Ellis is analogous art in addressing the problem of providing video contents to a server. The Rothschild reference disclose providing video messages through a Web server, but does not explicitly disclose the source of the video content being distributed. Ellis is analogous art in that Ellis addresses the problem of providing video content to a server, regardless of the type of distribution network the server may be connected to.

Second, applicant argues that Rothschild does not qualify as prior art (applicant's remarks, page 9).

In response, the priority document to which applicant attempts to claim priority, Provisional Application 60/174,781, provides not support for the video streaming server claim limitations found in the instant application, namely steps i-iv of claims 1 and 7, and corresponding the limitations regarding confirmation a video is in streaming format, storing the video at a network accessible location, and generating an identification tag containing a link to the network accessible location found in lines 6-9 of claim 36. Therefore the effective priority date of the Rothschild reference predates the effective priority date of the instant claims.

Third, applicant argues that there is no reference to any form of advertisements found in the "Streaming Email" reference (applicant's remark's, page 10).

In response, the reference to advertisement acquisition and selection is found in the Rothschild reference (see Rothschild, paragraphs 48-57).

Fourth, applicant argues that the "Streaming Email" reference appears to teach against a server based video sharing system (applicant's remarks, page 10).

In response, the "Streaming Email" reference in no way teaches against server based video sharing, because even if a user records a video and attaches

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it to an email message from their own hard drive, it is still uploaded to distributed from the email server through which the message is sent.

Lastly, applicant argues that the obviousness rejection for claim 36 suffers from hindsight reconstruction, citing the lack of explicit motivation from the prior art references themselves to achieve the claimed invention.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claims 1-6, and 36-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rothschild (US 2001/0047294 A1, of record) in view of "Streaming Email" (XP-002150023, supplied by applicant).

Regarding claim 1, Rothschild discloses a method of sending a video segment and an associated advertisement over a computer network (paragraph 48), comprising:

(a) acquiring a video segment at a computer system (the video portion of a video message, paragraph 48);

(b) acquiring advertisements at the computer system (third party, advertiser provided, advertisements, paragraph 49);

(c) offering to a sender an opportunity to indicate a selection of an advertisement of the advertisements to be associated with the video segment (pull down menu 404, paragraph 51);

(d) accepting from the sender the indication of a selection of the advertisement to be associated with the video segment (the send message button which indicates the sender has selected the desired advertisement and is ready to send the message, paragraph 53).

Rothschild fails to disclose directly in response to the indication accepted in step (d), automatically at the computer system:

(i) assuring that the video segment is in a streaming format;

(ii) creating an identifier for the video segment;

(iii) associating the video segment and the advertisement; and

(iv) sending the video segment, the identifier, and the associated advertisement over the computer network to a receiving computer system.

In an analogous art, "Streaming Email" teaches sending video email messages in streaming format by creating a pointer included in a text email message sent to a designated recipient which points to the network accessible location where the video has been stored in said streaming format (pgs. 308-313, "Video Express Email"), providing the benefit of sharing video messages with others that does not require transmission of the full video along with the email.

It would have been obvious at the time to a person of ordinary skill in the art to modify the method disclosed by Rothschild to include sending video email messages in streaming format (i) by creating a pointer included in a text email message sent to a designated recipient which points to the network accessible location where the video has been stored in said streaming format (ii-iv), as taught by "Streaming Email" for the benefit of sharing video messages with others that does not require transmission of the full video along with the email.

Regarding claim 2, Rothschild and "Streaming Email" disclose the method of claim 1, wherein the step of offering to a sender an opportunity to indicate a selection of an advertisement of the advertisements includes a criterion selectable by the sender (via pull down menu 404, Rothschild, paragraph 51).

Regarding claim 3, Rothschild and "Streaming Email" disclose the method of claim 2, wherein said criterion is a remuneration paid for selected said advertisement (Rothschild, paragraph 49).

Regarding claims 4-6, Rothschild and "Streaming Email" disclose the method of claims 1 and 2, and further disclose the step of offering to a sender an opportunity to indicate a selection of an advertisement includes a randomized default selection if the sender fails to indicate a selection (Rothschild, paragraph 52, where if the sender fails to select a particular advertisement, they may select that a randomly selected advertisement be shown).

Regarding claim 36, Rothschild teaches a method for operating a video-sharing server on a network comprising:

- storing a plurality of advertisements (paragraph 64); and
- receiving from a client a video, an electronic email address, and a selection of one of the plurality of advertisements (paragraph 57, wherein the email is a video message, paragraph 48).

Rothschild fails to disclose confirming that the video is in streaming format, storing the video at a network-accessible location, generating an identification tag including a link to the network accessible location, generating an electronic communication containing the link and addressed to the electronic email address, and transmitting the electronic communication.



In an analogous art, "Streaming Email" teaches sending video email messages in streaming format by creating a pointer included in a text email message sent to a designated recipient which points to the network accessible location where the video has been stored in said streaming format (pgs. 308-313, "Video Express Email"), providing the benefit of sharing video messages with others that does not require transmission of the full video along with the email.

It would have been obvious at the time to a person of ordinary skill in the art to modify the method disclosed by Rothschild to include sending video email messages in streaming format by creating a pointer included in a text email message sent to a designated recipient which points to the network accessible location where the video has been stored in said streaming format, as taught by "Streaming Email" for the benefit of sharing video messages with others that does not require transmission of the full video along with the email.

Regarding claim 37, Rothschild and "Streaming Email" disclose the method of claim 36, wherein receiving the video includes receiving an HTTP post (Rothschild teaches the email is assembled and transmitted via interactions with web site 110, paragraph 48).

Regarding claim 38, Rothschild and "Streaming Email" disclose the method of claim 36, but fail to disclose publishing the link to a Web page.

The examiner takes official notice that publishing links to videos in web pages is notoriously well known in the art.

It would have been obvious at the time to a person of ordinary skill in the art to modify the method of Rothschild and "Streaming Email" to include publishing the link to a Web page.

Regarding claim 39, Rothschild and "Streaming Email" disclose the method of claim 36, further comprising receiving a mailing list including a plurality of email addresses and transmitting the electronic message to the plurality of email messages (Rothschild teaches sending a single message to multiple recipients at once, paragraph 53).

Regarding claim 40, Rothschild and "Streaming Email" disclose the method of claim 36, wherein the link includes a path ("Streaming Email" teachings sending a pointer file which designates the location of the file for streaming, page 308).

5. Claims 7-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rothschild in view of "Streaming Email" and Ellis et al. (6,774,926, of record).

Regarding claim 7, Rothschild discloses a method of sending a video segment and an associated advertisement over a computer network (paragraph 48), comprising:

(a) acquiring a video segment at a computer system (the video portion of a video message, paragraph 48);

(b) selecting, by the sender, an advertisement stored at the server computer system (paragraphs 51-52); and

(c) transmitting from the sender computer to the server computer system an indication of the selected advertisement (paragraph 53).

Rothchild fails to disclose fails to disclose uploading a video segment from a sender computer system to the server computer system, and in response to receiving said indication the server computer system automatically:

(i) assures that the video segment is in a streaming format;

(ii) creates an identifier for the video segment;

(iii) associates the video segment and the advertisement; and

(iv) sends the video segment, the identifier, and the associated advertisement over the computer network to a receiving computer system.

In an analogous art, Ellis teaches uploading a video segment from a sender computer system to a server computer system (col. 3 line 55 – col. 4 line 4 and col. 7, lines 38-48), allowing smaller entities, such as home users, to create and provide video content (col. 3, lines 19-29).

It would have been obvious at the time to a person of ordinary skill in the art to modify the method disclosed by Rothschild to include uploading a video segment from a sender computer system to the server computer system, as taught by Ellis, for the benefit of allowing smaller entities, such as home users, to

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create and controllably provide video content, such as personalized, or special interest, content.

Rothchild and Ellis fail to disclose in response to receiving said indication the server computer system automatically:

- (i) assures that the video segment is in a streaming format;
- (ii) creates an identifier for the video segment;
- (iii) associates the video segment and the advertisement; and
- (iv) sends the video segment, the identifier, and the associated advertisement over the computer network to a receiving computer system.

In an analogous art, "Streaming Email" teaches sending video email messages in streaming format by creating a pointer included in a text email message sent to a designated recipient which points to the network accessible location where the video has been stored in said streaming format (pgs. 308-313, "Video Express Email"), providing the benefit of sharing video messages with others that does not require transmission of the full video along with the email.

It would have been obvious at the time to a person of ordinary skill in the art to modify the method disclosed by Rothschild to include sending video email messages in streaming format (i) by creating a pointer included in a text email message sent to a designated recipient which points to the network accessible location where the video has been stored in said streaming format (ii-iv), as taught by "Streaming Email" for the benefit of sharing video messages with others that does not require transmission of the full video along with the email.

Regarding claim 8, Rothschild, Ellis, and "Streaming Email" disclose the method of claim 7, wherein selecting an advertisement comprises using a criterion chosen by an operator of the sender computer system (Rothschild, paragraph 52).

Regarding claim 9, Rothschild, Ellis, and "Streaming Email" disclose the method of claim 8, wherein said criterion is a remuneration paid for selected said advertisement (Rothschild, paragraph 49).

Regarding claims 10 and 11, Rothschild, Ellis, and "Streaming Email" disclose the method of claim 8, wherein said criterion includes leaving said selection to the determination of said server computer system which selects the advertisement in a substantially randomized manner (Rothschild, paragraph 52).

6. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rothschild, Ellis, and "Streaming Email" as applied to claim 10 above, and further in view of Eldering et al. (6,820,277, of record) [Eldering].

Regarding claim 12, Rothschild, Ellis, and "Streaming Email" disclose the method of claim 10, but fail to disclose said selection is based on a price paid by an advertiser.

In an analogous art, Eldering discloses providing advertisers the opportunity to bid upon advertisement opportunities, awarding the advertisement time slot to the highest bidder (col. 8 line 63 – col. 9 line 12).

It would have been obvious at the time to a person of ordinary skill in the art to modify the method disclosed by Rothschild, Ellis, and "Streaming Email" to select an advertisement based on a price paid by an advertiser, as taught by Eldering, for the benefit of allowing advertisers to bid upon advertisement opportunities, maximizing the advertising revenues generated by the server computer system.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

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## Certificate of Mailing

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Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile transmissions and mailing, respectively.



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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dominic D. Saltarelli whose telephone number is (571) 272-7302. The examiner can normally be reached on Monday - Friday 9:00am - 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dominic Saltarelli  
Patent Examiner  
Art Unit 2611

DS



**JOHN MILLER**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 2600**